Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEF PEDAIN,
MANFRED BOCK and CARL-GERD DIERIS

Appeal No. 1999-1415
Application 08/784,875

ON BRIEF

Before WARREN, WALTZ and LIEBERMAN, *Administrative Patent Judges.*

WARREN, *Administrative Patent Judge.*

REMAND TO THE EXAMINER

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 CFR §1.196(a) (1997); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., August 2001; 1200-29 – 1200-30).

The sole ground of rejection on appeal, that is, appealed claims 1, 3, 5, 7, 9 through 11, 13, 15, 17 and 19 through 22[1] under 35 U.S.C. § 103(a) over Tate et al. in view of Bock et. al,[2]

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[1] These are all of the claims in the application.

[2] See answer, page 2. While the examiner states the ground of rejection as "Claims 1-22," we observe that appellants cancelled claims 2, 4, 6, 8, 12, 14, 16 and 18 in the preliminary amendment of January 16, 1997 (Paper No. 3), as recognized by the examiner in stating the ground of rejection in the final rejection of May 22, 1997 (Paper No. 4).

was most recently considered by another merits panel of this Board in Appeal No. 94-0150 in application 07/837,299.[3] In affirming the decision of the examiner in the original decision of October 31, 1995 (Paper No. 15) and on reconsideration of January 30, 1996 (Paper No. 17), the prior panel thoroughly considered the evidence of record in the specification and the Declaration of appellant Pedain as relied on by appellants. In doing so, the prior panel raised a number of issues with respect to whether the evidence demonstrates unexpected results (original decision, pages 8-9; reconsideration, pages 2-5). Among the issues raised by the prior panel is the matter of "Hazen" color value or number with respect to the Hazen yellowness test used in the specification Examples (e.g., reply brief, pages 3-4).

Appellants, admitting that the examiner has made out a *prima facie* case of obviousness, rely in the present appeal solely on the evidence of record and, in this respect, extensively address in the brief submitted in the present appeal (see in entirety) the issues with respect to the evidence raised by the immediate prior panel. Appellants submitted with the brief an exhibit which is "a translation of a description of 'color numbers' from Römpp Chemie Lexicon" with respect to Hazen color numbers (page 7).

In the *present* answer, the examiner merely refers the present panel to the following statement at page 5 of the answer in the *first* appeal (*see above* note 3):

> The [Pedain] declaration . . . is unconvincing.
>
> The patentability of the instantly claimed catalyst over the [Bock] catalyst is not the issue in the instant application since the catalyst used by Tate which is the primary reference is the same as that of the instant claims. [Paper No. 8, page 5; emphasis in the original deleted.]

Appellants responded to the later statement by the examiner in the present reply brief.

The admission of the translation attached to the brief, which is an "exhibit," is a matter for consideration by the primary examiner and governed by 37 CFR § 1.195 (1969). *See* MPEP § 1211.02 (8th ed., August 2001; 1200-30).

[3] The ground of rejection involving essentially the same claimed subject matter was first considered by yet another merits panel in Appeal No. 91-0137 in application 07/311,920, affirming the position of the examiner in the original decision of September 30, 1991 (Paper No. 13) and on reconsideration of January 15, 1992 (Paper No. 15).

There is no indication on this record whether the primary examiner has entered the translation.

Consideration of the evidence of nonobviousness submitted in rebuttal to a *prima facie* case of obviousness must also be considered by the primary examiner. *See* MPEP §§ 716.01 and 716.01(a) (8th ed., August 2001; 700-215 – 700-216).

It is manifest that the examiner did not consider the evidence in the record, including the translation, in light of appellants' arguments in the brief in response to the findings of the prior panel in the *second* appeal. It is clear that appellants' arguments with respect to the evidence that respond to the issues raised by the immediate prior panel creates a record that did not exist at the time of the *first* appeal, and thus the examiner's statements with respect to the evidence in the present answer are not relevant to the present record.

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to provide a supplemental answer fully considering the evidence of record in light of appellants' arguments in the brief *and* the reply brief, including stating whether the translation has been admitted and, if so, the effect thereof.

The supplemental answer must include the reason(s) why the evidence of record considered in light of appellants' arguments is not sufficient to rebut the *prima facie* case after again weighting the evidence of obviousness and nonobviousness, if the ground of rejection is maintained. *See generally, In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Johnson*, 747 F.2d 1456, 1460, 223 USPQ 1260, 1263 (Fed. Cir. 1984); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *see also* MPEP § 1211.02

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its "special" status, requires immediate action. *See* MPEP § 708.01(D) (8th ed., August 2001; 700-105). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case. *See, e.g.,* MPEP§ 1211 (8th ed., August 2001; 1200-30).

Remanded

CHARLES F. WARREN Administrative Patent Judge	)	
THOMAS A. WALTZ Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
PAUL LIEBERMAN Administrative Patent Judge	)	

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